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REMARKS

Claims 1, 2, and 26-35 are pending in the present application.

At the outset, Applicants wish to thank Examiner Bugaisky for the indication that Claims 1 and 2 are free of the art of record and would be allowed with the amendment to overcome the rejection under 35 U.S.C. §112, second paragraph (Office Action date October 2, 2003, page 3, lines 18-19).

The rejection of Claims 1 and 2 under 35 U.S.C. §112, second paragraph, is obviated by amendment.

Applicants wish to thank Examiner Bugaisky for the kind suggestion on how to amend these claims to overcome the present rejection. Consistent with this suggestion, Applicants have amended the claims hereinabove.

Withdrawal of this ground of rejection is requested.

Applicants note that Claims 26-35 have been added. Claims 26 and 31 depend from allowable Claims 1 and 2, respectively, and as such should be entered and allowed. Claims 27-30 and 32-35 are method claims that depend from Claims 1-2 and include all the limitations of the allowable product.

Further, Applicants remind the Examiner that MPEP §821.04 states:

...if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim *will be* rejoined.  
(emphasis added)

Accordingly, Applicants respectfully submit that Claims 27-30 and 32-35 should be entered and allowed based on the allowance of Claims 1 and 2 from which they depend.

Acknowledgment to this effect is respectfully requested.

Turning to the Examiner's objection to the Declaration, Applicants note that it appears that the Office has overlooked the substitute Declaration filed on June 21, 2001 in which the residence information has been provided. For the Examiner's convenience, Applicants submit herewith a copy of the substitute Declaration filed on June 21, 2001 along with a copy of the date-stamped filing receipt evidencing timely filing thereof.

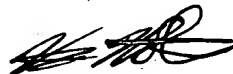
Finally, Applicants confirm the Examiner's indication that a signed copy of the Information Disclosure Statement (Form PTO-1449) filed on June 21, 2001 will be provided with the next action.

Application No. 09/884,948  
Reply to Office Action of October 2, 2003.

Applicants submit that the present application is now in condition for allowance.  
Early notification of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



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**SUBSTITUTE**

## Declaration, Power Of Attorney and Petition

**COPY**

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**WE (I) the undersigned inventor(s), hereby declare(s) that:**

My residence, post office address and citizenship are as stated below next to my name,

We (I) believe that we are (I am) the original, first, and joint (sole) inventor(s) of the subject matter which is claimed and for which a patent is sought on the invention specified.

## PROCESS FOR PRODUCING MICROBIAL TRANSGLUTAMINASE

the specification of which

**Q** is attached hereto.

EX was filed on July 2, 1998 at

Application Serial No. 09/109,059

and recorded on \_\_\_\_\_

☐ was filed as PCT International application

**Number** \_\_\_\_\_

02 \_\_\_\_\_

and was amended under PCT Article 19

on \_\_\_\_\_ (if applicable).

We (I) hereby state that we (I) have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

We (I) acknowledge the duty to disclose information known to be material to the patentability of this application as defined in Section 1.56 of Title 37 Code of Federal Regulations.

We (1) hereby claim foreign priority benefits under 35 U.S.C. § 119(a)-(d) or § 365(b) of any foreign application(s) for patent or inventor's certificate, or § 365(a) of any PCT International application which designated at least one country other than the United States, listed below and have also identified below, by checking the box, any foreign application for patent or inventor's certificate, or PCT International application having a filing date before that of the application on which priority is claimed. Prior Foreign Application(s)

Application No.	Country	Day/Month/Year	Priority Claimed
180010/1997	JAPAN	4 JULY 1997	<input checked="" type="checkbox"/> Yes <input type="checkbox"/> No
			<input type="checkbox"/> Yes <input type="checkbox"/> No
			<input type="checkbox"/> Yes <input type="checkbox"/> No
			<input type="checkbox"/> Yes <input type="checkbox"/> No

✓96

We (1) hereby claim the benefit under Title 35, United States Code, § 119(a) of any United States provisional application(s) listed below.

(Application Number)

**(Filing Date)**

(Application Number)

(Filing Date)

We (I) hereby claim the benefit under 35 U.S.C. § 120 of any United States application(s), or § 365(c) of any PCT International application designating the United States, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT International application in the number provided by the first paragraph of 35 U.S.C. § 112, I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR § 1.56 which became available between the filing date of the prior application and the national or PCT International filing date of this application.

Status (pending, patented,  
abandoned)

Application Serial No.

**Filing Date**

And we (1) hereby appoint: Norman F. Oblan, Reg. No. 24,618; Marvin J. Spivak, Reg. No. 24,913; C. Irvin McClelland, Reg. No. 21,124; Gregory J. Maier, Reg. No. 25,999; Arthur I. Neustadt, Reg. No. 24,854; Richard D. Kelly, Reg. No. 27,757; James D. Hamilton, Reg. No. 28,421; Eckhard H. Knorrer, Reg. No. 29,870; Robert T. Pous, Reg. No. 29,093; Charles L. Gholtz, Reg. No. 24,395; Vincent J. Sunderdick, Reg. No. 29,004; William E. Sammons, Reg. No. 30,994; Robert F. Gause, Reg. No. 27,295; Jean-Paul Lavilleye, Reg. No. 31,491; Stephen G. Baxter, Reg. No. 32,884; Robert W. Hahl, Reg. No. 33,893; Richard L. Trammor, Reg. No. 36,379; Steven P. Withrouch, Reg. No. 32,829; John T. Goolkasian, Reg. No. 26,142; Richard L. Chinn, Reg. No. 34,303; Steven E. Lipman, Reg. No. 30,011; Carl E. Schlier, Reg. No. 34,426; James J. Kulbacki, Reg. No. 34,648; Richard A. Neifeld, Reg. No. 35,299; J. Derek Mason, Reg. No. 35,270; Surinder Sechar, Reg. No. 34,423; Christine M. Gadiano, Reg. No. 37,628; Jeffrey B. Mulhryre, Reg. No. 38,867; Paul R. Ranch, Reg. No. 38,591; William T. Enos, Reg. No. 33,128; and Michael E. McCabe, Jr., Reg. No. 37,182; our (my) attorneys, with full powers of substitution and revocation, to prosecute this application and to transact all business in the Patent Office connected therewith; and we (1) hereby request that all correspondence regarding this application be sent to the firm of OBLON, SPIVAK, McCLELLAND, MAIER & NEUSTADT, P.C., whose Post Office Address is Fourth Floor, 1725 Jefferson Davis Highway, Arlington, Virginia 22202.

We (I) declare that all statements made herein of our (my) own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

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Heichi Miyazawa

**Signature of Inventor**

October 12, 1999



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October 12, 1999

Date

Tetsuya MIHA  
NAME OF THIRD JOINT INVENTOR

Tetsu Miha  
Signature of Inventor

October 12, 1999

Date

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Dept.: Chemical

By: NFO/DJP/km

OSMM&N File No. 209650US0DIV

Serial No. New U.S. APPLICATION

In the matter of the Application of: Keiichi YOKOYAMA et al

For: PROCESS FOR PRODUCING MICROBIAL TRANSGLUTAMINASE

The following has been received in the U.S. Patent Office on the date stamped hereon:

- ☒ 67 pp. Specification    25 Claims/Drawings    7 Sheets
- ☒ and 2 pages Application Data Sheet
- ☒ Combined Declaration, Petition & Power of Attorney    3 pages, Executed Copy
- ☐ List of Inventor Names and Addresses
- ☒ Utility Patent Application Transmittal
- ☒ Notice of Priority
- ☒ Check for \$710.00
- ☒ Fee Transmittal Form
- ☐ Assignment/PTO 1595 pages:
- ☐ Letter to Official Draftsman
- ☐ Letter Requesting Approval of Drawing Changes
- ☐ Drawings                      sheets    ☐ Formal
- ☒ Substitute Declaration, Petition & Power of Attorney, 3 pages, Executed Copy from parent application
- ☒ Preliminary Amendment w/copy of Substitute Sequence Listing attached (Paper)
- ☒ Information Disclosure Statement                      ☒ PTO-1449
- ☐
- ☐ Search Report
- ☐ Statement of Relevancy
- ☐ IDS/Related/List of Related Cases
- ☐ Restriction Response
- ☐ Rule 132 Declaration
- ☐ Request for Extension of Time
- ☐ Notice of Appeal
- ☐ Brief
- ☐ Issue Fee Transmittal
- ☒ White Advance Serial Number Card
- ☐ Small Entity Status is Claimed
- ☐ Marked-up copy
- ☐

- ☐ CPA
- ☐ Priority Doc
- ☒ Dep. Acct. Order Form

- ☐ Cited Pending Applications
- ☐ Election Response



Due Date: **JUNE 27, 2001**

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